

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Vakharia) Art Unit: 3781
Serial No.: 10/622,006)
Filed: July 17, 2003) Examiner: Mai
For: HEAD COVER FOR A GOLF CLUB) Docket No: T0095US
) September 6, 2007
) 750 B STREET, Suite 3120
) San Diego, CA 92101
)

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir,

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

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(1) Real Party in Interest

The real party in interest is Taylor Made Golf Co., Inc.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1-6 and 9-17 are pending, and Claims 7 and 8 have been canceled. Claims 2, 9, and 11 have been withdrawn from consideration by the examiner. The final rejections of Claims 1, 3-6, 10, 12, 13, 16, and 17 are appealed.

(4) Status of Amendments

No amendments are outstanding.

(5) Summary of Claimed Subject Matter

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 recites a head cover with golf club assembly that includes a golf club (reference numeral 102, figure 1; page 4, paragraph 19) having a head (100, figure 1; page 4, paragraph 19). A cover body (10, figure

1; page 4, paragraph 19: see also 50, figure 5; page 5, paragraph 22: see also 70, figure 6; page 6, paragraph 23) is formed essentially of flexible, non-rigid material. The cover body defines an inner compartment (defined by 12, figure 1; page 4, paragraph 19) accommodating the head and a lower portion (defined by 14, figure 1; page 4, paragraph 19) for surrounding a portion of a shaft (104, figure 1; page 4, paragraph 19) of the golf club and formed with at least first and second longitudinal edges (20, figure 1; page 4, paragraph 19) generally parallel to the shaft. The edges meet each other in a closed configuration and are distanced from each other in an open configuration. A first elongated magnetic fastener (26, figure 3; page 4, paragraph 19: see also 52, figure 5, page 5, paragraph 22: see also 80, figure 6; page 6, paragraph 23) is positioned along the first edge. A second elongated magnetic fastener (26, figure 3; page 4, paragraph 19: see also 52, figure 5, page 5, paragraph 22: see also 80, figure 6; page 6, paragraph 23) is positioned along the second edge and is attracted to the first magnetic fastener to hold the edges together in the closed configuration.

Claim 10 sets forth a head cover for golf club assembly that includes a golf club head (100, figure 1; page 4, paragraph 19) and a cover body (10, figure 1; page 4, paragraph 19: see also 50, figure 5; page 5, paragraph 22: see also 70, figure 6; page 6, paragraph 23). The cover body has an inner liner (32, figure 4; page 5, paragraph 21) and an outer cover (34, figure 4; page 5, paragraph 21). Both the inner liner and outer cover are formed essentially of flexible, non-rigid material defining a compartment (defined by 12, figure 1; page 4, paragraph 19) holding the head and defining an elongated closable opening of sufficient size for the head to be inserted into and removed from the inner compartment. The opening defines a pair of first and second elongated edges (20, figure 1; page 4, paragraph 19) generally parallel to each other. A magnetic fastener (26, figure 3; page 4, paragraph 19: see also 52, figure 5, page 5, paragraph 22: see also 80, figure 6; page 6, paragraph 23) has first and second elongated magnetic portions spaced apart from one another and

arranged along respective edges. The magnetic portions attract each other to hold the edges together to at least partially shut the opening.

Claim 17 requires, in a method for engaging a golf club head cover (10, figure 1; page 4, paragraph 19; see also 50, figure 5; page 5, paragraph 22; see also 70, figure 6; page 6, paragraph 23) with a golf club (reference numeral 102, figure 1; page 4, paragraph 19), forming the head cover with an upper portion (12, figure 1; page 4, paragraph 19) that is configured to receive a head of the golf club and a lower portion (14, figure 1; page 4, paragraph 19) configured to surround a shaft of the golf club. The method includes establishing an elongated slit in the lower portion, with the slit being manually movable to an open configuration. At least one pair of opposed edges (20, figure 1; page 4, paragraph 19) of the slit are distanced from each other such that the golf club can be received into and removed from the head cover. The slit is movable to a closed configuration, wherein the edges are held together. The method includes moving the slit to the open configuration, engaging the head cover with the club, moving the slit to the closed configuration, and then using first and second magnetic assemblies (26, figure 3; page 4, paragraph 19; see also 52, figure 5, page 5, paragraph 22; see also 80, figure 6; page 6, paragraph 23) mounted in the head cover to attract each other to hold the edges together and thereby establish the closed configuration.

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Independent Claims 1 and 17 and dependent Claims 3-5 and 16 have been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow, USPN 3,145,749 in view of Russell, USPN 3,161,932 or Kurt, USPN 3,008,209.

(b) Independent Claim 10 and dependent Claims 6, 12, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow in view of Russell or Kurt and further in view of Lauretti, USPN 2,422,245.

(c) Independent Claims 1 and 10 and dependent Claims 3-7 (sic, 3-6), 12, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Lauretti in view of Russell or Kurt.

(7) Argument

a. Obviousness Rejections of Independent Claims 1 and 17 and Dependent Claims 3-5 and 16 Based on Rosenow in View of Russell or Kurt

The issues can be simply put before entering into a more detailed discussion. The present invention is to a golf club head cover that is held closed by magnets. The references of record show two examples of head covers (Rosenow and Lauretti) that use conventional zippers, but that nowhere teach or suggest anything about magnets. To supply the shortfall, two secondary references (Russell and Kurt) have been relied on. Russell uses magnets to fasten baby clothes. Kurt uses magnets for clothing as well. Based on the apparent belief that combining baby clothes with golf club head covers is legally legitimate, the claims stand rejected.

a. (1) Russell and Kurt are Not Analogous to the Present Invention

To rely on a reference under 35 U.S.C. §103, it must be analogous prior art, MPEP §2141.01(a). To be analogous, a reference must be one which, because of the subject matter with which it deals, logically would have commended itself to an inventor's attention in solving his problem, in this case, in how to

conveniently cover the head and part of the shaft of a golf club, *id.* Of central importance in making the analogousness determination is similarity and differences in structure and function, *id.* In making this consideration, an initial step in defining what is and is not analogous art is to define the person of ordinary skill in the art of the subject invention, since if a person of ordinary skill in the relevant art is for example a dyer, not a chemist, the person may have no knowledge of chemistry and hence chemical references would not be analogous, *Dystar Textilfarben GmbH v. C. H. Patrick Co.*, 464 F.3d 1356 (Fed. Cir. 2006). The burden in establishing analogousness lies with the proponent of a reference, in this case, with the examiner.

MPEP 2141.01(a)(IV) ("ANALOGY IN THE MECHANICAL ARTS") offers an illuminating example that is essentially on all fours with the present facts. The very first example cited is *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The MPEP summarizes that the applicant in this case claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The Commissioner further argued in the brief on appeal that a disengageable catch is a common everyday mechanical concept, however the court held that the Commissioner did not explain why a "catch" of unstated structure is such a concept, and why it would have made the claimed invention obvious.

Accordingly, with the above legal background in mind, in the present case it must be first determined, based on evidence, who the person of ordinary skill in the art is, and then, for each reference below, evidence must be produced to show why its field so seemingly alien to golf clubs nonetheless logically would have commended itself to the skilled artisan:

1. Russell (fasteners for baby dresses, thus having markedly different function if not structure than the present claims and hence being *prima facie* non-analogous absent refutative evidence of record, which has not been produced).
2. Kurt (fasteners for clothing, presumably not just baby dresses but in any case having markedly different function if not structure than the present claims and hence being *prima facie* non-analogous absent refutative evidence of record, which has not been produced).

The rejection utterly fails to comply with any of the requirements above. It fails, for example, to offer evidence as to who the person of skill in the art is, much less what the level of skill is for this hypothetical person. It further fails to demonstrate, using evidentiary support, why the ordinarily skilled golf club head cover artisan would logically look to the clothing art for ideas.

Instead, the rejection relies on the last desperate resort often employed by a proponent of unpatentability who seeks to use a plainly non-analogous reference, namely, overly broadly characterizing what the "field" is. Specifically, on page 3, line 17 of the Office Action, the examiner appears to define the field as "the field of covering". But this overly broad characterization of the "field" is belied by the claims, which do not recite "covers" in a vacuum but which instead explicitly require a golf club head, and a cover to cover

that head - in other words, the specific type of cover known as a "golf club head cover" (see, e.g., the preamble of Claim 1, as supported by the body of the claim.) Under the examiner's wide net, there would be no principled reason not to find that car covers, bed covers, and for that matter condoms are analogous to the present claims.

On page 3 of the Office Action, last two lines, the examiner points to col. 4, line 6 of Kurt for the proposition that Kurt's fastener can be applied to "fabric, cloth, cover, garment, apparel, tarpaulin, bag, container, or other device". But the reliance on this single sentence snatched from Kurt ignores the reference as a whole, which is improper under MPEP 2141.02. Specifically, the rejection ignores the ensuing illustration of what this means, in addition to just clothing, at line 11 et seq., namely, "large, heavy material such as canvas". Nowhere does Kurt mention anything about sports applications, much less golfing, or that his closure might in some way be suitable for such an unmentioned application. The only specific applications Kurt mentions thus are clothes and large, heavy material such as canvas.

Simply because a reference states that it may be widely applied to unmentioned "devices" does not transform it into analogous art for every invention under the sun, any more than generic statements in patents can substitute for teachings or suggestions of explicitly claimed species that are otherwise never envisioned in the prior art. Because the present claims are drawn to a specific type of golf club head cover, because baby clothes (Russell) and clothing fasteners (Kurt) on their face are not analogous to golf club head covers, and because the examiner has failed to comply with the requirements of the MPEP and the case law in demonstrating analoguousness, the rejections merit reversal.

a. (2) Insufficient Motivation Exists to Combine Russell and Kurt with Rosenow

It is undisputed that Rosenow fails to mention magnets, much less suggest that magnets are equivalent to golf head cover zippers. It is also undisputed that the secondary (magnet) references do not even mention the word "golf" or suggest use of their fasteners in any specific application beyond clothing and large heavy canvas.

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court suggested that patentability more likely will be found in cases, as here, in which more than a mere substitution of parts for their known functions is implicated. Kurt does not teach that using magnets to close golf club head covers is a known function for its closure, and no reference has been cited for this teaching. Under *KSR*, the rejections merit reversal.

b. Obviousness Rejections of Dependent Claims 6, 10, 12, and 13 Based on Rosenow in View of Russell or Kurt and further in view of Lauretti

The rejection of Claims 6, 10, 12, and 13 based on Rosenow in view of Russell or Kurt and further in view of Lauretti falls because (1) neither Russell nor Kurt is analogous to the present claims; (2) there is no suggestion in either Russell or Kurt that it may be used with golf clubs, much less that it is equivalent to the golf club head cover zipper of Rosenow; and (3) Rosenow nowhere suggests an equivalence between head cover zippers and magnets.

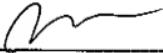
c. Obviousness Rejections of All Appealed Claims Based on Lauretti in View of Russell or Kurt

The rejection of Claims 1, 3-6, 10, 12, and 13 based on Lauretti in view of Russell or Kurt falls for reasons above. Lauretti nowhere mentions that magnets may be equivalently used for its closure, and the paucity of golf-related teachings in the secondary references has been treated above.

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APPENDIX A - APPEALED CLAIMS

1. A head cover with golf club assembly comprising:
 - a golf club having a head;
 - a cover body formed essentially of flexible, non-rigid material, the cover body defining an inner compartment accommodating the head, the body also defining a lower portion for surrounding at least a portion of a shaft of the golf club and formed with at least first and second longitudinal edges generally parallel to the shaft, the edges meeting each other in a closed configuration, the edges being distanced from each other in an open configuration;
 - at least a first elongated magnetic fastener positioned along the first edge; and
 - at least a second elongated magnetic fastener positioned along the second edge and being attracted to the first magnetic fastener to hold the edges together in the closed configuration.
3. An assembly as defined in claim 1, wherein:
the magnetic fastener includes first and second magnetic strips, each disposed in respective first and second edges.
4. An assembly as defined in claim 3, wherein the magnetic strips each comprise a plurality of magnets.
5. An assembly as defined in claim 4, wherein, the magnetic strips each comprise at least four magnets disposed in a conforming sleeve.

6. An assembly as defined in claim 1, wherein the cover body comprises a cushioned inner liner and an outer cover.

10. A head cover for golf club assembly comprising:

a golf club head;

a cover body having an inner liner and an outer cover, both formed essentially of flexible, non-rigid material defining an compartment holding the head and defining an elongated closable opening of sufficient size for the head to be inserted into and removed from the inner compartment, the opening defining at least one pair of first and second elongated edges, the edges being generally parallel to each other; and

a magnetic fastener having first and second elongated magnetic portions spaced apart from one another and arranged along respective edges, the magnetic portions attracting each other to hold the edges together to at least partially shut the opening.

12. A head cover for golf club assembly as defined in claim 10, wherein:

the first and second magnetic portions are magnetic strips disposed in the elongated edges such that the magnetic strips can attract one another to at least partially secure the opening.

13. A head cover for golf club assembly as defined in claim 12, wherein the magnetic strips each comprise a plurality of magnets.

14. A head cover for golf club assembly as defined in claim 12, wherein the magnetic strips each comprise a plurality of magnets disposed in heat shrink tubing.

15. A head cover for golf club assembly as defined in claim 14, wherein the pair of elongated edges is defined by a pair of elastic cords attached to the inner liner and the outer cover, the elastic cords having the magnetic strips disposed therein.

16. The head cover for golf club assembly of claim 1, wherein the inner compartment is sized and configured to conform generally to the head.

17. A method for engaging a golf club head cover with a golf club, comprising:
forming the head cover with an upper portion configured to receive a head of the golf club and a lower portion configured to surround a shaft of the golf club;
establishing at least one elongated slit in the lower portion, the slit being manually movable to an open configuration, wherein at least one pair of opposed edges of the slit are distanced from each other such that the golf club can be received into and removed from the head cover, the slit being movable to a closed configuration, wherein the edges are held together;
moving the slit to the open configuration;
engaging the head cover with the club;
moving the slit to the closed configuration; and

using at least first and second magnetic assemblies mounted in the head cover to attract each other to hold the edges together and thereby establish the closed configuration.

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APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)